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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/778,003	02/12/2004	Walter Aldaz	MRKS/0101	4450

7590 04/18/2007
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EXAMINER

NEUDER, WILLIAM P

ART UNIT	PAPER NUMBER
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3672

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/778,003	ALDAZ ET AL.	
	Examiner	Art Unit	
	William P. Neuder	3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 80-87,91-96,112-115,117-127 and 129-157 is/are allowed.
- 6) ☒ Claim(s) 1,3,4,7,10,11,14,47-50,55,98-103,107,109-111 and 158 is/are rejected.
- 7) ☒ Claim(s) 8,12,13,15,51,52,54,56,104-106 and 108 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/17/07</u> | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are 1,3,4,7,8,10-15,47-52,54-56,80-87,91-96,98-115,117-127 and 129-158.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,4,7,10,11,14,47-49,55,98-103,107,109-11 and 158 are rejected under 35 U.S.C. 102(e) as being anticipated by Brezinski et al 6,854,522.

Brezinski discloses a sealing apparatus for use in a wellbore. Looking mainly at figures 38-41, an expandable tubular support member 530 has a flow port (unnumbered) through the sidewall. Inflatable seal elements 538 and 540 are positioned around the ports. The flow port provides a path between the interior of the expandable tubular to a chamber defined between the seal element and the outside wall of the tubular where the seal is inflated upon an increase in fluid pressure. As to claim 4, the chamber is adapted for inflation by fluid from within the tubular. AS to claim 7, the chamber is annular. As to claim 10, the fluid is considered a filler material adapted to maintain the seal in sealing engagement with the wellbore. As to claim 11, the fluid fills the chamber to cause inflation of the seal. As to claim 14, the seal is inflated by applied fluid pressure. As to claim 47, any number of isolators 538,540 may be provided. As to claim 48, the expandable seals are axially spaced. As to claim 49, the spaced seals are

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connected by the expandable tubular. AS to claim 55, the expandable tubular can be perforated. AS to claim 98, the seal are located in the well. The expandable tubular is expanded and the seals inflated radially outward into engagement with the wellbore. As to claim 99, the tubular can be expanded mechanically. AS to claim 100, the seal is inflated when the tubular is expanded. As to claim 101, fluid pressure maintains the seal element in engagement with the wellbore. As to claim 102, the seal is inflated by supplying fluid under pressure to the seal. As to claim 103, a chamber is defined between the seal and the outer surface of the tubular. As to claim 107, fig. 39 shows the wellbore enlarged. As to claim 109, multiple sealing elements can be provided coupled together. As to claim 110, the seals are coupled by the expandable tubular. As to claim 11, the tubular is expanded. As to claim 158, the inflated seal circumferentially contacts the wellbore.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 3 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brezinski et al (described above).

As to claim 3, while Brezinski discloses open hole, it would have been considered an obvious design choice to use the device of Brezinski in a cased well. As to claim 50, it would have been considered an obvious design choice to use an expandable sandscreen as the expandable tubular in Brezinski.

Allowable Subject Matter

Claims 8,12,13,15,51,52,54,56,104-106 and 108 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 80-87,91-86,112-115,117-127 and 129-157 are allowed.

Response to Arguments

Applicant's arguments with respect to claims 1,3,4,7,10,11,14,47-50,55,98-103,107,109-111 and 158 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Neuder whose telephone number is 571-272-7032. The examiner can normally be reached on Tuesday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



William P Neuder
Primary Examiner
Art Unit 3672

W.P.N.